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Jerrold V. Flatt

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EXAMINER

RINES, ROBERT D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Jerrold V. Flatt

Appeal 2008-4096
Application 09/992,764
Technology Center 3600

Decided: January 27, 2009

Before, ANTON W. FETTING, DAVID B. WALKER, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-3, 5-18, 20-23, and 25. Claims 4, 19, 24, and 26-27 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is directed to web site accessible by a plurality of health care providers. A request for a patient consultation from a first health care provider to be given by a second health care provider is received at the web site. The request may include insurance, patient, and appointment information. The second health care provider may choose to accept or decline the request for patient consultation. (Specification, 3:6-7). Claim 1, reproduced below, is representative of the subject matter of appeal.

Claim 1: A method of managing patient referrals, comprising:

providing a web site accessible to a plurality of health care providers;

receiving through the web site, a plurality of health care provider registrations each associated with a health care provider;

receiving a request for a patient consultation from a first health care provider to be performed by a second health care provider, both the first health care provider and the second health care provider having a health care provider registration;

notifying the second health care provider of the request for a patient consultation according to a preferred mode of communication setting set by the second health care provider on the web site; and

receiving a peer rating from the first health care provider of the second health care provider.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Kiselik	US 2001/0034631 A1	Oct. 25, 2001
Filler	US 2001/0051881 A1	Dec. 13, 2001
Bianco	US 2002/0082865 A1	Jun. 27, 2002

The following rejections are before us for review:

1. Claims 1-3, 5-18, 20-23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Filler, Bianco, and Kiselik.
2. Claim 25 is rejected under 35 U.S.C. § 103(a) as unpatentable over Filler and Bianco.

THE ISSUE

The issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-3, 5-17, and 25, the issue turns on whether Bianco discloses “a preferred mode of communication setting set by the second health care provider or consulting physician on the web site.”

With regards to claims 18 and 20-23, the issue turns on whether Bianco discloses “a mode of communication preference set by a referring health care provider.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence¹:

FF1. The Specification at pages 19-20, recites “As shown in Fig. 7B, this web page can show preferences for the mode of notification such as a fax, pager, and/or e-mail.”

FF2. Fig. 7B of the Specification displays a figure of a webpage in which boxes for a fax, pager, or e-mail maybe “checked” to be notified.

FF3. *Webster’s New World Dictionary, Third College Edition* (1988), defines “preferred” as: 3) to put before something or someone else in one’s liking, opinion, etc.; like better.

FF4. *Webster’s New World Dictionary, Third College Edition* (1988), defines “set” or “setting” as: 3) to put in a certain place or position; cause to be, lie, stand, etc. in place.

FF5. Bianco discloses a “Message Center” in Figure 11A which only displays a single e-mail communication mode [0109].

FF6. Bianco discloses that the physician may use a message center similar to the patients [0135].

FF7. Bianco’s patient registration shown in Figure 9C discloses modes of communication being through the street address, day time phone number, evening phone number, and e-mail address. Figure 9C lists possible modes of communication, but no “preferred mode” is disclosed or identified.

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF8. Bianco's physician registration shown in Figures 24A-C discloses modes of communication being through the street address, day time phone number, evening phone number, and e-mail address. Figures 24A-C lists possible modes of communication, but no "preferred mode" is disclosed or identified.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

ANALYSIS

Claim Construction

We first construe the meaning of the phrase "a preferred mode of communication setting set by the second health care provider on the web

site” as used by the Appellant in the claim 1. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’”

Phillips v. AWH Corp., 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. See *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

The Specification at page 20, lines 1-2, recites “As shown in Fig. 7B, this web page can show preferences for the mode of notification such as a fax, pager, and/or e-mail” (FF1). Fig. 7B of the Specification displays a figure of a webpage in which boxes for a fax, pager, or e-mail maybe “checked” to be notified (FF2). Further a conventional definition of the word “preferred” is “to put before something or someone else in one’s liking, opinion, etc.; like better” (FF3). A conventional definition of “set” or “setting” is “to put in a certain place or position; cause to be, lie, stand, etc. in place.” Giving the phrase “a preferred mode of communication setting set by the second health care provider on the web site” its broadest reasonable interpretation in light of the Specification, we find that the word “preferred” to require there to be more than one possible mode of communication since some “preference” is required to take place and that some mode be identified as “preferred.” We also find the phrase “setting set” to require that something is “set” or “put into position” in the system. Claims 18 and 25

contain phrases similar to that identified in claim 1 and are similarly construed.

Claim Analysis

The Appellant argues that the rejections of claims 1, 18, and 25 under 35 U.S.C. § 103(a) as unpatentable over Filler, Bianco, and Kiselik are improper because the Bianco reference fails to disclose the “preferred mode of communications” be a “setting set” by the “health care provider.” (Reply Br. 6-7). The Appellant argues that in Bianco’s disclosure that a physician enters a list of *possible* contact information instead of a *preferred* mode of communication (Reply Br. 7, emphasis added). The Appellant further clarifies his argument by stating:

“The selection of a preferred mode of communications as described in the context of the claimed invention therefore relates to a selection between one or more different possible modes of communication via the website, not merely a physician contemplating which email address to input into the system (Br. 4).

In contrast, the Examiner has found that Bianco does disclose “a preferred mode of communications” by the e-mail address and registration features disclosed by Bianco in paragraphs 0109, 0135, 0102 and Fig. 9C. The Examiner argues that Bianco discloses the cited claimed limitations under the broadest reasonable interpretation of the claims (Ans. 18-19). The Examiner has also found that the physician could enter a message stating the preferred mode of communication in the General Comments section of the website (Ans. 19).

We agree with the Appellant. Claim 1 requires “a preferred mode of communication setting set by the second health care provider on the web

site.” Bianco discloses several modes of communication being entered such as the street address, day time phone number, evening phone number, and an e-mail address (FF7, FF8) however this only lists *possible* modes of communication, and no “*preferred* mode” is disclosed as the claim requires. Bianco also discloses a “Message Center” in Figure 11A but this only discloses one mode of communication which by e-mail (FF5). Thus in the embodiment of Bianco in Figure 11A, there is not “a preferred mode or communication setting set by the second health care provider on the web site” since the single e-mail address is the *only* mode of communication entered and a *preferred* mode of communication *setting set* by the health care provider has not taken place. With regards to the Examiner’s position that the “General Comments” section of the Bianco website could be used to enter a preferred mode of communication, we determine this to be the use of improper hindsight and not supported by the reference. For the above reasons, the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Filler and Bianco is not sustained. Claim 18 contains limitations similar to claim 1 and the rejection of this claim is not sustained for the same reasons. The rejection of dependent claims 2-3, 5-17, 21-23 is not sustained for the same reasons given above.

Claim 25 contains limitations similar to claim 1 and the rejection of claim 25 under 35 U.S.C. § 103(a) as unpatentable over Filler and Bianco is not sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-3, 5-18, and 20-23 under 35 U.S.C. § 103(a) as unpatentable over Filler, Bianco, and Kiselik.

We conclude that Appellant has shown that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) as unpatentable over Filler and Bianco.

DECISION

The Examiner's rejection of claims 1-3, 5-18, 20-23, and 25 is not sustained.

REVERSED

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